

Request for Continued Examination

The Applicants are concurrently filing a Request for Continued Examination (RCE) that accompanies this response.

Claim Rejections – 35 U.S.C. § 101

Claim 20 has been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In light of the amendments made to claim 20, the Applicants believe that this rejection is deemed moot.

Thus, the Applicants respectfully request that the rejection of claim 20 under 35 U.S.C. § 101 be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Claims 1-10, 13-19, and 21-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,159,095 to Frohm et al. (“Frohm”). The Applicants respectfully request that the Examiner reconsider and withdraw this rejection in light of the following remarks.

“For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim”. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Independent Claim 1

Independent claim 1 of the present invention recites an extendable display “having a first position out of a field of view of a player and a second position in a field of view of a player”. Independent claim 1 also recites “a physical obstruction, the first position of the extendable display being located behind the physical obstruction”. Additionally, claim 1 recites “a drive mechanism connected to the extendable display adapted to move the extendable display in a first direction from the first position to the second position and adapted to move the extendable display in a second direction from the second position to the first position”. Claim 1 further requires “a central processing unit adapted to signal the drive mechanism to translate the extendable display between the first position and the second position.”

Frohm is directed to an electronic video gaming machine for simultaneously playing multiple games. Frohm, Abstract, col. 1, ll. 11-12, col. 2, ll. 22-23. Multiple game boards are

arranged in a stacked fashion. *Id.*, Abstract, col. 2, ll. 33-34. A player may select from the stack a number of game boards to be played. *Id.*, Abstract, col. 2, ll. 41-42. Thus, the gaming machine of Frohm allows a player to play multiple hands at once, thereby increasing the chance of at least one hand resulting in a winning combination. *Id.*, col. 1, ll. 40-42.

The Applicants respectfully submit that Frohm does not disclose, teach, or suggest every element of claim 1. For example, Frohm does not disclose, teach, or suggest an extendable display “having a first position out of a field of view of a player . . . the first position of the extendable display being located behind the physical obstruction”, as required by claim 1. The cited portions of Frohm are directed solely to video elements (i.e., game boards). Thus, although some of these elements of Frohm are out of a field of view of a player, the elements are not located behind a physical obstruction, as required by claim 1. *See, e.g.*, Frohm, col. 2, ll. 46-50; FIGs. 1-2 and 4-6. Furthermore, the two-dimensional nature of the video-type gaming machine of Frohm makes it impossible for a video game board to be located behind another video game board. The game boards of Frohm are, therefore, not located behind a physical obstruction, as further required by claim 1.

Additionally, Frohm does not disclose the element of “a drive mechanism connected to the extendable display adapted to move the extendable display in a first direction from the first position to the second position and adapted to move the extendable display in a second direction from the second position to the first position.” FIG. 7 of the present invention provides an example of how the drive mechanism 65 may be connected to the extendable display 41. In making its rejection, the Office Action relies upon a portion of Frohm stating that “the winning game board appears to pop-up from the stack in cash-register-like fashion such that the face of the winning game board is more visible relative to prior said game board popping up.” *Id.*, col. 2, ll. 42-45. Nowhere in this cited portion, or any other portion of Frohm, is a drive mechanism disclosed. The reason for this is that Frohm’s game boards are on a video display where no drive mechanism is present.

In this regard, the Office Action inaccurately states, “Frohm does state that the disclosure ‘shall be understood herein to encompass video, as well as mechanical implementations’”. Office Action, p. 5-6 (citing Frohm, col. 10, ll. 12-16) (emphasis added). In actuality, this portion of Frohm states that “the terms ‘reels,’ ‘spinning reels,’ etc., and the like shall be understood herein to encompass video, as well as mechanical implementations”. Frohm, col. 10, ll. 14-16 (emphasis

added). Moreover, the portion of Frohm relied upon by the Office Action to reject claim 1 (i.e., Frohm, col. 2, ll. 41-50; col. 5, ll. 38-40) has nothing to do with “reels, spinning reels, etc., and the like”. See Office Action, p. 3. Rather, these portions disclose “a number of game boards” that are stacked (Frohm, col. 2, ll. 41-42) and dealing cards into each hand of the game board, as shown in FIG. 1 (*id.*, col. 5, ll. 36-39). Furthermore, because FIG. 1 of Frohm illustrates over twenty different game boards stacked on top of one another, incorporating over twenty mechanical drive mechanisms into the embodiment of FIG. 1 of Frohm would be seemingly impractical, if not impossible.

Additionally, because the Applicants submit that a drive mechanism is not disclosed in Frohm, the element of “a central processing unit adapted to signal the drive mechanism to translate the extendable display” is also not disclosed.

Furthermore, incorporating mechanical drive mechanisms into Frohm would render Frohm unsatisfactory for its intended purpose. See *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). The purpose of Frohm is to provide electronic video gaming machines that provide advantages over other types of gaming machines (e.g., mechanical) (Frohm, col. 2, ll. 10-18), such as allowing a player to play multiple games simultaneously (*id.*, col. 1, ll. 10-12), using less space (*id.*, col. 1, ll. 60-63), and promptly displaying the shape of a winning array on the display (*id.*, col. 2, ll. 1-4). Frohm states:

Electronic video gaming machines provide definite advantages for the player and casino operator over traditional versions. This is especially true for electronic video machines having the capability of playing multiple games at the same time. Because of these advantages in player appeal and excitement relative to traditional non-video versions, there is a continuing need for gaming manufacturers to produce new types of games and attractive enhancements.

Id., col. 2, ll. 10-19. Thus, because modifying the embodiments described in Frohm to include mechanical features would make Frohm unsatisfactory for its intended purpose of providing enhanced “player appeal and excitement relative to traditional non-video versions” (*id.*, col. 2, ll. 14-15), there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125.

Thus, the Applicants respectfully submit that claim 1 is allowable over Frohm because Frohm does not disclose every element of the claim. The Applicants respectfully submit that claims 2-8, which depend from claim 1, are allowable for at least the same reasons.

Dependent Claim 2

Claim 2, which depends from claim 1, further recites “**an aperture** adapted to allow the player to view the extendable display in the second position” (emphasis added). The Office Action has rejected claim 2 as being anticipated by Frohm because “Frohm discloses a gaming machine wherein the game display has an aperture adapted to allow the player to view the extendable display in the second position”. Office Action, p. 3-4. In support of this assertion, the Office Action cites the following portion of Frohm: “The face of any game board is viewable by the player by touching the touch screen at a location of the game board to be viewed. After touching the game board, the game board slides out from the stack to expose the face.” Frohm, col. 2, ll. 47-50. The Applicants respectfully submit that this cited portion does not disclose a “simulated aperture,” as the Office Action suggests. Office Action, p. 4. Rather, the cited portion merely describes a traditional video gaming display where elements appear on the display. Thus, an aperture is neither required nor disclosed by Frohm and is, thus, not anticipated by Frohm.

Thus, for at least these reasons as well as for those reasons set forth above with respect to claim 1, the Applicants submit that claim 2 is allowable over Frohm.

Dependent Claim 4

Dependent claim 4, which depends from claim 1, further requires that “the drive mechanism **rotates** the extendable display between the first position and the second position” (emphasis added). Thus, claim 4 requires that the drive mechanism actually physically rotate the extendable display. The gaming machines of Frohm, on the other hand, merely include graphical images depicting the game boards sliding but do not actually physically move, much less rotate. Thus, the cited portion of Frohm, which states, “After touching the game board, the game board slides out from the stack to expose its face,” is clearly distinguishable from claim 4. Frohm, col. 2, ll. 49-50. Frohm further states that “the winning game board appears to pop-up from the stack in a cash-register-like fashion.” Frohm, Abstract, col. 2, ll. 43-45, col. 5, *see also*, col. 5, ll. 43-45. Again, popping-up in a cash-register-like fashion is different from rotating. Therefore, the limitations of claim 4 are not disclosed, taught, or suggested by Frohm.

Thus, for at least these reasons, as well as for the reasons set forth above with respect to claim 1, the Applicants submit that claim 4 is allowable over Frohm.

Dependent Claim 7

Claim 7, which depends from independent claim 1, requires that “the extendable display is a scroll mechanism having a plurality of indicia, each of the plurality of indicia being individually

selectable.” In finding claim 7 to be anticipated by Frohm, the Office Action relies on a portion of Frohm that states, “In one embodiment, the player selects the number of game boards 20 in each stack section 88 by using indicators 32 or buttons 46 on the deck 70 to increase the number of game boards 20.” Office Action, p. 4; Frohm, col. 5, ll. 8-11. This cited portion does not disclose a “scrolling mechanism,” as required by claim 7. The Office Action summarizes this relied upon portion as disclosing “a plurality of game boards in a stack [that] may be selected and extended.” Office Action, p. 4. Assuming, *arguendo*, that this summary is accurate, it still does not explain how the disclosure of a “scrolling mechanism” may be gleaned from the relied upon portion – or any other portion – of Frohm. The Applicants submit that the reason for this is that the scrolling mechanism element of claim 7 is **not** disclosed in Frohm.

Thus, the Applicants submit that claim 7 is allowable for at least these reasons as well as for the reasons discussed above with respect to independent claim 1.

Independent Claim 8

Independent claim 8 recites, a plurality of extendable displays “having a first position located **behind** and **a distance away from** a static obstruction” and “a drive mechanism selectably engageable to each of the plurality of extendable displays”.

Frohm does not include extendable displays “located behind and a distance away from” a static obstruction. As described above with respect to claim 1, the two-dimensional nature of the video elements of Frohm is such that the video game boards cannot be located **behind** – much less **a distance away from** – an obstruction, as required by claim 8.

Furthermore, as explained in detail above with respect to claim 1, Frohm also does not disclose a mechanical “drive mechanism.” Thus, this element of claim 8 is also not disclosed, taught, or suggested in Frohm.

Thus, for at least these reasons and for those reasons provided above with respect to claim 1, the Applicants respectfully submit that independent claim 8 and its dependent claims 9-12 are allowable.

Dependent Claim 9

Dependent claim 9 calls for the drive mechanism to rotate the extendable display. The Applicants respectfully submit that claim 9, which depends from claim 8, is allowable for at least the reasons set forth above with respect to claims 4 and 8.

Independent Claim 13

Claim 13 requires “locating an extendable display in the game display behind a **physical** obstruction at a first position out of a field of view of a player” and “moving the extendable display in a first direction to a second position.” Claim 13 further requires “moving the extendable display in a second direction to return the extendable display to the first position behind the physical obstruction.” Frohm does not disclose the act of **locating** an extendable display. Furthermore, as discussed above with respect to claim 1, Frohm does not disclose an extendable display being located **behind a physical obstruction**. As further discussed above regarding claim 1, Frohm does not disclose returning the game board to its original positions behind the physical obstruction. Thus, the “first direction” and “second direction” limitations of claim 13 are not disclosed in Frohm.

Therefore, for at least these reasons, as well as for the reasons provided above with respect to claim 1, the Applicants respectfully submit that claim 13 and its dependent claims 14-18 are allowable over Frohm.

Dependent Claim 15

Dependent claim 15 recites that “the game display has an aperture aligned with the second position of the extendable display.” The Applicants respectfully submit that claim 15, which depends from claim 13, is allowable for at least the reasons set forth above with respect to claims 2 and 13.

Dependent Claim 17

Claim 17 recites that “the drive mechanism rotates the extendable display between the first position and the second position.” The Applicants respectfully submit that claim 17, which depends from claim 13, is allowable for at least the reasons set forth above with respect to claims 4 and 13.

Independent Claim 19

Independent claim 19 recites, “**locating** a plurality of extendable displays behind a **physical** obstruction in the game display”. Claim 19 further recites “signaling a **drive mechanism** with the central processing unit to extend the selected extendable display into a field of view of a player.”

The Applicants respectfully submit that claim 19 and its dependent claims 20-22 are allowable for at least the same reasons set forth above with respect to claims 1 and 13.

Dependent Claim 21

Dependent claim 21 recites that “the drive mechanism rotationally translates the selected extendable display.” The Applicants respectfully submit that claim 21, which depends from claim 19, is allowable for at least the reasons set forth above with respect to claims 4 and 19.

Independent Claim 23

Claim 23 requires an extendable display “having a first position out of a field of view of a player, the extendable display further having a second position partially in a field of view of a player, the extendable display further having a third position in a field of view of a player”. Thus, claim 23 requires that the extendable display have at least **three distinct positions**, which are not disclosed in Frohm.

It appears that the Office Action is taking inconsistent positions with respect to the positions of the cards of Frohm. For example, on page 6, the Office Action states, “[t]he card is hidden and **not partially in the field of view** because no information may be read from the card.” Office Action, p. 6 (emphasis added). Page 7 of the Office Action, on the other hand, states that “a cash-register style pop up **includes a partially hidden view** between a hidden and visible view.” Office Action, p. 7 (emphasis added). The Applicants submit that only two positions are disclosed by Frohm: one that is partially visible and one that is “more visible” to a player. *See* Frohm, col. 2, ll. 45-46, FIG. 1. At no time, however, does Frohm disclose three distinct positions, as required by claim 23. Accordingly, the limitation “a central processing unit adapted to signal the drive mechanism to translate the extendable display from the first position to the second position” is also not anticipated by Frohm.

Claim 23 further recites “the first position being located behind and a distance away from a static obstruction.” This element is not disclosed by Frohm for at least the reasons set forth above with respect to claim 8.

Thus, for at least these reasons as well as for the other reasons discussed above with respect to claim 1, the Applicants submit that claim 23 is allowable over Frohm.

Claim Rejections – 35 U.S.C. § 103

Claims 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Frohm.

First, the Applicants note that each of claims 11 and 12 depend from independent claim 8, the novelty of which is presented above. Thus, claims 11 and 12 are believed to be allowable for at least the same reasons as claim 8.

Furthermore, the portion of Frohm relied upon by the Office Action in rejecting claims 11 and 12 states, “The microprocessor then operates according to its game program . . . and, using technology well known in the art, causes each of the reels to stop at the preselected stop position.” Office Action, p. 5; Frohm, col. 9, ll. 26-30. This disclosure essentially describes the operation of

traditional mechanical gaming machines. Furthermore, this cited portion of Frohm does not apply to FIG. 1, the embodiment relied upon to reject the claims. Nowhere in Frohm is there disclosed “a plurality of concentrically oriented shafts,” let alone connecting “each of the plurality of shafts . . . **to at least one extendable display**,” as required by claim 11. Furthermore, nowhere in Frohm is there disclosed “a plurality of solenoid valves, each solenoid valve being connected to one of the plurality of extendable displays, each of the plurality of solenoid valves adapted to linearly translate the extendable display”, as required by claim 12. The Applicants further submit that these elements would not have been obvious to one skilled in the art.

Thus, for at least these reasons, the Applicants submit that claims 11 and 12 are allowable over Frohm.

Information Disclosure Statement

Submitted herewith is a supplemental information disclosure statement. Applicants request that this information disclosure statement be entered and that the references listed in the enclosed PTO-1449 form be considered and made of record by the Examiner.

Conclusion

It is the Applicants' belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested. The Applicants respectfully request that a timely Notice of Allowance be issued in this case. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is the Applicants' belief that no further fees are due at this time. However, should the Applicants be mistaken, the Commissioner is authorized to charge any fees that may be required (except for payment of the issue fee) to Nixon Peabody LLP, Deposit Account No. 50-4181, Order No. 247079-000228USPT. A duplicate copy of this paper is enclosed.

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Respectfully submitted,

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